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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,360	12/11/2001	Jean-Claude Pailles	214946US2PCT	9239
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WORJLOH, JALATEE	
			ART UNIT 3621	PAPER NUMBER
			NOTIFICATION DATE 09/24/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/926,360	Applicant(s) PAILLES ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 2-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 1-13) in the reply filed on 07/02/2007 is acknowledged. The traversal is on the ground(s) that "a search and examination of the entire application would not place a serious burden on the Examiner". This is not found persuasive because The inventions listed as Groups I, II, III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- The combination as claimed does not require the particulars of the subcombination as claimed because the process of Group II is not required in Group I. The subcombination has separate utility such as means of processing a first message and receiving and processing a third message. Also, Group I relates to authorizing the use of a software program.
- The combination as claimed does not require the particulars of the subcombination as claimed because the process of Group III is not required in Group I. The subcombination has separate utility such as recording the payment request with at least the identity of the user and of the software editor, the amount to be paid and the means of crediting the software editor with said amount.
- The combination as claimed does not require the particulars of the subcombination as claimed because the process of Group IV is not required in Group I. The subcombination has separate utility such as a smart card reader with a smart card containing the identity

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of a software user, whereby the card reader and card are able to receive a message containing proof that the user has accepted a software user offer.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 07/02/2007.

Specification

3. The abstract of the disclosure is objected to because of a minor informality. Please remove the heading "Fig.1" from the abstract (see middle of page). Correction is required. See MPEP § 608.01(b).

Remarks

"Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

[Emphasis in original.]" MPEP §2106 II C.

Functional recitation(s) using the word "for" or other functional language (*e.g.* "able to", "whereby") have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in

¹ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

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which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115.

Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

4. Claims 1-13 have been examined.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites “a payment module”, but it is unclear whether this module is software or hardware.

8. Claim 1 recites “means of message”, but it is unclear what is meant by this phrase. What is the means of message? Is it means for sending a message? A means for receiving a message?

9. The term “notably” in claim 1 is a relative term, which renders the claim indefinite. The term “notably” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

although all limitations must be considered, not all limitations are entitled to patentable weight).

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apprised of the scope of the invention. The phrase "notably contains" does not teach a range, which defines the scope, therefore it is unclear as to whether the message contains the data or not.

10. Claim 1 recites "should he/she so accept, and, if so, compose a second message requesting payment", but does not explain what happens if the message is not accepted.

11. Claim 1 recites, "if they agree, authorize use of the software program", but does not explain what happens if they do not agree.

12. Claim 1 recites the limitation "the means of processing's signature" in line 36. There is insufficient antecedent basis for this limitation in the claim.

13. Claims 2-13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 2-23 recites the intended use language whereby, which does not further limit the claim. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001). Also see Remarks above.

14. Claim 2 recites the limitation "the digital signature by the editor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 2 recites the limitation "the digital signature by the editor"; however, it is unclear what is meant by this phrase.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5794207 to Walker et al. ("Walker").

Walker discloses the software interface is able to compose a first message offering use of the software (i.e. digital good), and is sent to the payment module (i.e. central controller) (see col. 20, lines 32-34; col. 22, lines 53-67 – a counter offer is sent to the central controller), the payment module is able to receive said first message, display it, receive the acceptance of the software user (i.e. buyer) should he/she so accept, and if so, compose a second message (i.e. message to the clearinghouse) requesting payment to the means of message and payment processing (i.e. clearinghouse) (see col. 23, lines 2-18), the means of message and payment processing are able to receive the second message, check the proof it contains, record the payment request with at least the identity of the user and of the software editor and the amount to be paid, and credit the editor with said amount, said means are also able to compose a third message, which is a payment settlement (see col. 21, lines 27-36 – the clearing house is able to performing these features), the software interface is additionally able to check the means of processing's signature against the offer parameters contained in the first message, and if they agree, authorize use of the software program (i.e. Walker system is able to perform this step – fig. 16). Also note, "The recitation of a new intended use for an old product does not make a

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claim to that old product patentable” *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Walker does not expressly disclose said first message notably contains the identity of the software editor, offer parameters and the editor’s digital signature for at least part of the software offered, the second message contains the identity of the user and of the software editor together with proof that the user accepts the offer and the third message contains the identity of the means of processing and a digital signature constituting proof of payment, and is addressed to the payment module. However, these differences are only found in the nonfunctional material is not functionally involved in the system. The process where the first, second, and third messages are sent would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to send a message having any type of content because such data does not functionally relate to the process and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 2-13 recite the functional language whereby. These claims have been considered but are given little patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. Thus, claims 2-13 are rejected on the same rationale as claim 1 above.

² See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

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Conclusion

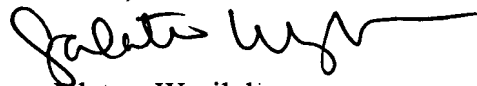
18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6226618 to Downs et al. discloses an electronic content delivery system.
- US Publication NO. 20040073515 to Stefik et al. discloses a method for metering and pricing of digital works.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jalatee Worjloh

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Primary Examiner
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September 12, 2007